



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,674	08/27/1999	NEIL L. MAYLE	2000581-0002	8145

7590 04/30/2002

DOUGLAS D ROBINOW
CHOATE HALL & STEWART
EXCHANGE PLACE
53 STATE STREET
BOSTON, MA 02109

EXAMINER

MAUNG, ZARNI

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 04/30/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Cd

Office Action Summary

	Application No. <u>09-08/384,674</u>	Applicant(s) <u>Mayle et al.</u>
	Examiner <u>Zarni Maung</u>	Art Unit <u>2154</u>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Aug 27, 1999.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 8-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 20) Other: _____

Art Unit: 2154

DETAILED ACTION

1. This action is responsive to the preliminary amendment filed on August 27, 1999.

Claims 8-15 are pending and claims 1-7 have been canceled.

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 8-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,018,774 (hereinafter '774 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Art Unit: 2154

4. As per claims 1-6 of the '774 patent contains the subject matter claimed in the instant application. Taking claim 8 of the application as an exemplary claim, the patent and the application are claiming common subject matter, as follows:

A server computer having an input interface for receiving user information, input user information from the input interface, the user information including electronic image data and destination data specifying at least one destination, and storing the user information in a storage device and processing the electronic image data, generating message including a portion of the processed electronic image data, and sending the message to a receiving destination specified by the destination data.

Claims 8 of the pending application contains additional limitations of at least one CPU, storage device and generating a display including at least a portion of the processed electronic image data.

However, the additional limitations that included in claim 1 of the pending application are merely obvious variations in view of the limitations recited in claims 1-6 of the '774. The process of using CPU, a storage are inherently included in the sending and the receiving computers of the claims. The process of generating display including at least portion of the processed electronic image data is obvious modification of the processes for "associating an identifier with the stored image data, and generating a message including the identifier" as claimed in the '774 patent. Therefore, the limitations recited in pending claims are directed to similar limitations recited in claims 1-6 of the '774 patent with merely obvious variations. All other depending claims 9-15

Art Unit: 2154

are directed to very similar limitations recited in the dependent claims 2-6 of the '774 patent with only obvious modifications.

Applying *In re Vogel et al.*, 164 USPQ 619 (CCPA 1970), "Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?", the pending claims contain merely an obvious variation of the invention disclosed and claimed in '774 patent.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:
A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Art Unit: 2154

6. Claims 8-15 are rejected under 35 U.S.C. § 103 as obvious over Wright et al., U.S. Patent Number 5,426,594 (hereinafter Wright).

Wright discloses a system and method for sharing an electronic greeting card in a communication system (see figure 1, system 100). Wright discloses the invention substantially as claimed. Taking claim 8 as an exemplary claim, Wright discloses a system for generation of a display including image comprising: a server computer (see mail server 136) having: at least one CPU, a storage device, an input interface for receiving user information (see server 136, CPU is inherent, memory is inherent because server stored the high resolution images for electronic greeting cards in advanced in a compressed form; see column 7, lines 60-65), and a communications interface adapted for exchange of information between computers (see column 7, lines 14-65, column 10, lines 34-40, column 11, lines 10-15, column 14, lines 14-63, sever 136 sends and receives electronic card via communication interface to and from the communication device 102) , wherein a combination of said server and an electronic greeting card store 142 adapted by a program to input user information from the input interface, the user information including electronic image data and destination data specifying at least one destination (see column 4, lines 5-60, column 5, lines 14-21, column 13, lines 20-24; store the user information in the storage device; process the electronic image data; generate the image including at least a portion of the processed electronic image data; associate an identifier with the image (see column 13, lines 14-61, server 136 receives the request for card, extracts the card ID and destination

Art Unit: 2154

information); create a message including the identifier; and send the message via the communications interface to the at least one destination specified by the destination data (see column 4, lines 5-60, column 5, lines 14-57, column 13, lines 20-24, see column 13, lines 14-61, server 136 receives the request for card, extracts the card ID and destination information, and sending the card from the card store 142 to the requesting destination).

Wright does not explicitly show the process of generating a display and creating a message including the identifier at the server 136, because the combination of the server 136 and card store 142 generates and creates the card and ID information (see (see column 4, lines 5-60, column 5, lines 14-57, column 13, lines 20-24, see column 13, lines 14-61, server 136 and card store 142). However, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Wright by performing the generating and creating the card at the server instead of the combination of the server 136 and card store 142, because doing so would have enabled the system to eliminate the separate card stores which require longer communications time to access electronic cards.

7. As per claim 9, Wright discloses the system of claim 8 wherein the storage device further comprises long term storage and short term storage (see column 7, lines 60-65, library and database located in server 136).

Art Unit: 2154

8. As per claim 10, Wright discloses the system of claim 9, wherein the CPU is further adapted to store the image display in the storage device and associate the identifier with the image display stored in the storage device (see column 13, lines 14-61).

9. As per claim 11, Wright discloses the system of claim 8, wherein the input interface is a client computer connected to the server (see figure 1, interface 132, 134, 130).

10. As per claim 12, Wright discloses the system of claim 1 wherein the client computer is connected via the communications interface (see figure 1, interface 132, 134, 130, 112, 110).

11. As per claim 13, Wright discloses the system of claims 8 or 12 wherein the communications interface is a network adaptor for interfacing to a network (see figure 1, interface 132, 134, 130, 112, 110; network adaptor is inherently included in TX and RX).

12. As per claim 14, Wright discloses the system of claim 8 wherein the CPU is further adapted to process the electronic image data via at least one operation selected from the set of operations comprising: scaling, rotating, centering, mirroring, filtering,

Art Unit: 2154

formatting, compressing, decompressing, color correcting, composting, cropping, blurring, captioning, adding motifs, adding visual effects and combinations thereof (see column 6, lines 23-24, column 7 line 10 to column 8 line 65, column 12, lines 20-34, column 13, lines 14-66, scaling rotating, centering, mirroring, filtering, formatting, compressing, decompressing, color correcting, composting, cropping, blurring, captioning, adding motifs, adding visual effects and combinations are inherently included in the generation of three dimensional hologram images).

13. As per claim 15, Wright discloses the system of claim 8 wherein the CPU is further adapted to transmit the image display associated with the identifier in response to a request including the identifier received via the communications interface (see column 13, lines 14 to column 14, line 54).

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- (a) Image reading method having reading conditions different in light quantity by Yamaguchi, U.S. Patent Number 6316761.
- (b) Centrally coordinated communication systems with multiple broadcast data objects and response tracking by Erickson, U.S. Patent Number 6014644.
- (c) Seamless integration of internet resources by Jones et al., U.S. Patent Number 6026429.

Art Unit: 2154

(d) Image distribution method and system by Sheridan, U.S. Patent Number 5760917.

(e) Remote retrieval and display management of electronic document with incorporated images by Cordell et al., U.S. Patent Number 5778372.

(f) Interactive kiosk for selecting and sending mail pieces by Denman, U.S. Patent Number 5737729.

(g) Method and apparatus for displaying business cards by Dickinson, U.S. Patent Number 5732229.

(h) Method and apparatus for document verification and tracking by Wolff et al., U.S. Patent Number 5671282.

(I) Universal message storage system by Jones, U.S. Patent Number 5832221.

15. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zarni Maung whose telephone number is (703) 308-6687. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax phone number for

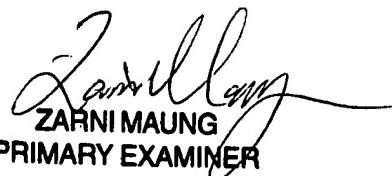
Art Unit: 2154

this Group is (703) 308-9052. Additionally, the fax numbers for Group 2100 are as follows:

Official Faxes: (703) 746-7239
After Final Responses: (703) 746-7238
Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-3900.

April 24, 2002



ZARNI MAUNG
PRIMARY EXAMINER